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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,911	11/11/2003	Chang Han Shen	105199-638-RI	2377
24964	7590	01/04/2005	EXAMINER	
GOODWIN PROCTER L.L.P 103 EISENHOWER PARKWAY ROSELAND, NJ 07068			JOHNSON, BLAIR M	
			ART UNIT	PAPER NUMBER

3634

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/712,911

**Applicant(s)**

SHEN, CHANG HAN

**Examiner**

Blair M. Johnson

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 2 is/are allowed.
- 6) ☒ Claim(s) 3-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### ***Reissue Applications***

Claims 3-14 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 3,5,7,8,10 and 13 do not include the annular body of the patented claims. In arguing for the patentability of the claims over the prior art during the prosecution of US patent No. 6,431,245, Applicant argued that the prior art “does not show the use of the ‘annular member’ located on the bottom tube”, page 6 of the only amendment in the prosecution of ‘245.

Also omitted from claims 3 and 7, et al, are the “locating means” and the “active pull cord”, both of which were argued as injecting patentable subject matter into the eventual patent claims of ‘245. The relationship of the side pull cords and the middle

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pull cord, still recited, with the active pull cord and the locating member is extensively discussed on page 5 of the arguments of the '245 amendment. At the bottom of page 5 is the statement: "This structure allows the present invention to achieve advantages neither shown or suggested by the prior art Rupel and Schon patents". Additionally, on page 6 of these same arguments, Applicant stated the prior art "still lack[s] the arrangement of pull cords connected to the locating member, and would still lack the ability to easily manipulate the window shade into the unique form shown in the drawings of the present invention". Also, claim 7 fails to include the tubes as originally recited. Applicant, on page 7 of the aforementioned amendment, argues: "that without the middle tube, it is not possible to achieve a clear and uncrumpled presentation of the curved portion of the window shade. On this basis, Applicant respectfully contends that the present invention is patentably distinguishable from the prior art references". Also stated in regards to the tubes, on page 6: "Importantly, the Rupel patent does not use the middle tube. As a result, it is not possible to achieve the advantage of the present invention by lifting the bottom tube upwardly toward the middle tube with out lifting the entire shade so as to achieve the configuration shown in FIGURE 3 of the Rupel patent." Currently, claim 7 omits this highly praised feature.

As referenced above, Office policy is directed by the following decisions: Pannu V. Storz Instruments

Inc., 258 F.3d 1366, 59 USPQ2d 1597 ; Ex parte Yamaguchi, 61 USPQ2d 1043.

Among the criteria for evaluating recapture, it must be determined whether the reissue claim entirely omits any limitation that was argued during the original prosecution to overcome an art rejection (Pannu). The "annular body", "locating

member", "active pull cord" and tube features, now omitted in the independent claims 3 and 7, as well as certain dependent claims, were argued as being patentable over the prior art applied, as carefully detailed above. It is to be emphasized that these features have not been broadened, they have been omitted altogether.

MPEP 1412.02 is very clear that arguments alone can establish surrendered subject matter. Again, this applies to the present facts.

***Claim Rejections - 35 USC § 103***

Claims 7 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rupel '257.

See top rail 15, pull cord 18, first side cord 19 and second side cord 20. The "sections" are comprised of bottom section 17a-c, top section where the shade is attached to the headrail 15, and "therebetween section" between the top and bottom sections. Pull cord 18 is attached to the bottom section and the side cords are attached to the "therebetween section" by virtue of the going through the holes in the pleated shade. What is not shown is cord 18 going through the same "arresting member" as cords 19 and 20. However, merely rerouting cord 18 through the right end of the headrail, i.e. locating lock 25 adjacent lock 27, would have been obvious so as to provide complete activation of the shade from one side of the blind. See the annular body in the form of circular hole C'. The actuating members are the holes in the headrail through which cords 18, 19 and 20 extend and by which they are redirected.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

Applicant has overcome the objection under 37 CFR 1.171(a).

The rejection under 35 USC 251, based upon recapture, is still in effect. The recapture issue was clearly discussed in the first Office action and has been repeated herein.

Regarding the 103 rejection under *Rupel et al*, it is noted that merely "sections" of the pleated shade have been recited. These "sections" are met as discussed above. Applicant, in his remarks, argues that *Rupel et al* does not provide "well defined" portions of the shade. The phrase "well defined" does not appear in the claims, and it is further doubted that such terminology would avoid *Rupel et al*. The term "section" is broad and reads on any portion of the shade and especially as discussed above in the rejection.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blair M. Johnson whose telephone number is (703) 308-0526. The examiner can normally be reached on Mon.-Fri., 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (703) 308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Blair M. Johnson  
Primary Examiner  
Art Unit 3634

BMJ  
01/03/05